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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,762	12/16/1999	STEPHEN FULD	SA9-99-081	8025

7590 03/24/2004

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EXAMINER
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CHEN, ALAN S

ART UNIT	PAPER NUMBER
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2182

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DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/464,762

Applicant(s)

FULD ET AL.

Examiner

Alan S Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-9,13-15 and 20 is/are rejected.
- 7) ☒ Claim(s) 3-6,10-12 and 16-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because Fig. 2, element 130 needs to be labeled with text that describes what the numeral 130 is referring to with respect to the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,7-9,13-15 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by No. 6,219,751 to Hodges.

4. As per claim 1,8 and 14 Hodges discloses a method, system and storage media for enabling a computer that processes data formatted in a first format to read a data unit that is formatted in a second format (Column 4, lines 43-55 and Column 5, lines 30 to 45 where the two formats are CKD and FBA formats) from a storage subsystem (Fig. 2A, element 211) that is capable of storing data in either first format or second format (Fig. 1 and 2A, show that albeit the data is converted to a particular format, it is capable of storing handle both formats, which is in the scope of the language of the claims, e.g., “capable of storing data”), said method comprising

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the steps of: a) dispatching, from said computer to said storage subsystem, a command for said storage subsystem to report a data length of said data unit (as stated in Column 5, lines 30-45, the data is converted from variable-length CKD format to fixed-block length FBA format, hence, it is inherent that the data command will necessitate the length of the CKD format in order for the conversion to be achieved; b) sending, from said storage subsystem to said computer, a value of said data length that enables said computer to determine whether said data unit is in said first format or in said second format and prepare for receipt of said data unit having said data length (Fig. 2A, element 200 sends requests to Fig. 2A, element 201 and 203); c) dispatching, from said computer to said storage subsystem, a command for said storage subsystem to forward said data unit to said computer (Fig. 2A, element 211 to 200); and d) sending said data unit from said storage subsystem to said computer (Fig. 2A, element 211 to 200).

5. As per claims 2, 9 and 15, Hodges discloses claim 1, wherein said first format is a count, key and data format (Column 5, lines 30-45) and said second format is a SCSI format (Fig. 2B, lines 45-60).

6. As per claims 7, 13 and 20, Hodges discloses claim 1, wherein said computer backs up said data unit in accordance with a multiple virtual storage (MVS) backup procedure (Column 4, lines 43-55, uses the MVS OS and having a mainframe that has RAID backup).

*Allowable Subject Matter*

7. Claims 3-6, 10-12 and 16-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to :

U.S. Pat. No. US006141731A to Beardsley et al.


U.S. Pat. No. US006449697B1 to Beardsley et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S Chen whose telephone number is 703-605-0708. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASC  
03/12/2004

  
JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2182